

The device comprises a hard internal breast plate which is formed to provide a right cup and left cup. In order to allow the device to compress the breasts, means for applying pressure to the cups must be provided. Newly added independent claim 11 provides a first strap, which engages the right cup opposite the center sternum area, and a second strap, which engages the left cup opposite the center sternum area. These straps apply pressure to the cups.

Since each cup is hard, if the device were completely rigid, the straps could not work to adequately provide compression of the breasts. Accordingly, a center sternum area must be provided, and the center sternum area must have flexibility along a longitudinal axis between the right cup and the left cup. When pressure is applied to each cup by means of the strap, the hard breast plate compresses each breast, and the center sternum area acts as a hinge to facilitate the application of the compression force against the breasts.

II. CLAIMS 11 THROUGH 22 DO NOT IMPROPERLY RECAPTURE SUBJECT MATTER

Claims 5 through 10, now cancelled, were rejected under 35 U.S.C. §251, as improperly recapturing claimed subject matter which was previously surrendered. Without discussing the merits of the rejection, it is respectfully submitted that Claims 11 through 16 are not an improper recapture under 35 U.S.C. §251.

An improper recapture does not occur where the claims in the reissue are broader in one respect, if they are narrower in another respect, and the "narrowing

limitation has a material aspect to it. If the narrowing limitation has a material aspect to it, then there is no recapture". MPEP §1412.02.

Claim 11 is broader than Claim 1 of Holliday, U.S. Patent 5,769,688, in that element b) requiring a soft rubberized foam exterior and interior surrounding the entirety of the hard internal breast plate is omitted. However, Claim 11 is narrower in that it requires that the hard internal breast plate not extend to a lower region of the woman's ribcage. Further, Claim 11 is narrower in that it requires a first strap which engages the right cup opposite the center sternum area, and a second strap which engages the left cup opposite the center sternum area.

The limitation that the hard internal breast plate not extend to a lower region of the woman's ribcage is material in that it distinguishes the device from UK Patent Application GB 2 069 318A, as further discussed herein. Further, the first strap and the second strap are material to the present invention, since the first strap and the second strap apply pressure to the hard internal breast plate, which forms the right cup and the left cup, to compress the breasts. The first strap and the second strap work in concert with the flexible center sternum area, which flexes as pressure is applied by means of the straps. These narrowing limitations are not "incidental, mere verbiage, nor would (they) be inherent even if not recited." MPEP §1412.02 . Accordingly, the Claims do not represent an improper recapture.

III. CLAIMS 11 THROUGH 22 ARE NOT ANTICIPATED BY THE PRIOR ART.

A. REQUIREMENTS OF A REFERENCE UNDER 35 U.S.C. §102 (B)

Anticipation of a claim under 35 U.S.C. §102 can only be found if the prior art reference discloses every element of the claim, *In re Paulsen.*, 30 F.3d 1475, 1478-79 (Fed.Cir.1994). Anticipation requires the presence, in a single prior art disclosure, of all elements of a claimed invention arranged as in the claim; a prior art disclosure that "almost" meets the claim is not anticipation. *Structural Rubber Products Co. v. Park Rubber Co.*, 749 F.2d 707, 716 (Fed.Cir.1984). Anticipation requires proof by clear and convincing evidence. *Shearing v. Iolab Corp.*, 975 F.2d 1541, 1544 (Fed.Cir.1992). A 102(b) reference must contain a disclosure which would enable someone to practice the invention as claimed. *Reading & Bates Const. v. Baker Energy Res.*, 748 F.2d 645 (Fed.Cir.1984).

B. DISCUSSION

Claims 5 and 7, now cancelled, were rejected under 35 U.S.C. §102 as being anticipated by the UK Patent Application. the UK Patent Application discloses a "unitary front piece or shield 1 to which are fashioned various straps which secure the front piece to the wearer in use. Front piece 1 is preferably formed from 3mm clear polyethylene sheet." Page 1, lines 34 through 38. "The front piece is of sufficient area to completely envelop the breast and to extend down to the lower region of the rib cage." Page 1, lines 53 through 56.

Claim 11 is distinguished from the device disclosed in the UK Patent Application. Claim 11, in element a), requires that the hard internal breast plate not extend to the

lower region of the woman's ribcage. UK Patent Application requires that the shield extend to the lower region of the ribcage, as quoted above. See also Figure 1 of the UK Patent Application.

The UK Patent Application also shows a series of straps. However, the straps are not shown as engaging a right cup or a left cup, as is required by the elements c) and d) of Claim 11. The straps in the UK Patent Application are shown as engaging the shield near the lower region of the ribcage. The positioning of these straps is not material to the UK Patent Application since there is no intention to use the straps to apply pressure to the breast area of the shield to compress the breasts.

The Official Action states that the right cup, left cup and sternum are "flexible along the center since the entire protector is "semi-rigid", not entirely rigid, and would thereby allow for flexibility as claimed and in that it is 3mm thick polyethylene it would allow for the claimed flexibility." It is respectfully submitted that if the device of the UK Patent Application is formed of a unitary sheet of 3mm clear polyethylene, it cannot meet the limitation of claim 11, which both forms a hard internal breast plate, and also provides flexibility along a longitudinal axis passing between the center sternum area. The device shown in Figure 1 of the completely envelops the breast and extends down to the lower region of the ribcage. It cannot both be flexible along the center sternum area and provide hard cups to compress the breasts, if formed of a unitary sheet of uniform thickness. The resulting material is either sufficiently thin to allow flexibility along the extended sternum, and does not, therefore, yield a hard breast plate which

forms a right cup and a left cup, or it is sufficiently hard to meet the limitation of forming the hard internal breast plate of Claim 11, but does not provide flexibility along the center sternum.

The device shown in the UK Patent Application, for the reasons aforesaid, does not meet the limitations of Claim 11. Newly added Claims 12 through 16 depend from Claim 11, and accordingly, the limitations of the dependent claims are not met.

Claims 5, 7, 9 and 10, now cancelled, were rejected under 35 U.S.C. §102(b), as being anticipated by Barnes.

Barnes does not disclose a hard internal breast plate formed to provide a right cup and a left cup. Barnes discloses a first cup 54 and a completely separate cup 56 secured together by an elastic straps and elastic center piece 60. This is not a hard internal breast plate which is formed to provide a left and a right cup.

While Barnes provides a first strap and a second strap, Barnes does not teach a hard internal breast plate, and therefore does not recognize the application of pressure to compress the breast by means of a first strap and a second strap, while providing flexibility in a center sternum area along a longitudinal axis.

Newly added Claim 12 requests a hard internal breast plate is required to be formed as a unitary member to provide the right cup, the left cup and the center sternum area. This limitation is not met by Barnes.

Newly added dependent claim 13, which depends from Claim 11, requires that the center sternum area not be a strap which comprises elastic. The center piece 60 of Barnes which connects the cups, presumably at the sternum, is an elastic strap.

It is respectfully submitted that claims 11 through 16 are in condition for allowance.

Claims 17 through 22 correspond to claims 11 through 16. Independent Claim 17 replaces the straps with "means for applying pressure to said right cup" and "means for applying pressure to said left cup."

IV. CONCLUSION

It is respectfully submitted that claims 11 through 22 are in condition for allowance, and that U.S. Patent No. 5,769,688 should be reissued with claims 1 through 5, and claims 11 through 22. **Applicant's Attorney respectfully requests a telephone call from the Examiner, if a discussion will expedite prosecution of the Application.**

Respectfully submitted,



B. Craig Killough
Attorney for Applicant
Registration Number 30,398
134 Meeting Street
P.O. Drawer H
Charleston, SC 29402
(843) 577-7700

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